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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/749,653	MOSS ET AL.
	Examiner	Art Unit	
	MATTHEW L. HAMILTON	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 May 2009</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-25 and 27-32</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-25 and 27-32</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

Response to Amendment

1.   This action is in reply to the amendment filed on 06 May 2009. Claims 1, 3-4, 13, 15, 21, 27 and

31-32 have been amended. Claims 1-25 and 27-32 are currently pending and have been examined.

Previous Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,
> subject to the conditions and requirements of this title.

3.   <u>Claims 1-20</u> are rejected under 35 U.S.C. 101 because the claimed invention, which is interpreted

to be a computer program, does not fall within at least one of the four statutory categories of invention

enumerated by 35 U.S.C. 101 (MPEP § 2106.IV.B). Computer programs are nonstatutory functional

descriptive material (MPEP § 2106.01.I, last para.). The amended independent claims are not sufficient

to overcome the rejection. In order to overcome the rejection the applicant must tie-in or incorporate

physical structure to the components recited in the claims. The rejection is maintained.

4.   <u>Claims 21-25 and 27-32</u> are rejected under 35 U.S.C. 101 because the claimed invention is not

directed to statutory subject matter. Based on Supreme Court precedent, to be patent eligible under 35

U.S.C. 101 a method/process claim must (1) be tied to a particular machine or apparatus or (2) transform

a particular article into a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 70 (1972);

Diamond v. Diehr, 450 U.S. 192 (1981); Parker v. Flook, 437 U.S. 589 n.9 (1978); and Cochrane v.

Deener, 94 U.S. 780, 788 (1876)). Furthermore, the Supreme Court held that the use of a particular

machine or transformation of an article must impose meaningful limits on the claim's scope to impart

patentability (Benson, 409 U.S. 71-72). The involvement of the machine or transformation must not

merely be insignificant extra-solution activity (Flook, 437 U.S. 590). Also see In re Bilski, No. 2007-1130,

_F.3d_, 2008 WL4757. The amended independent claims are not sufficient to overcome the rejection.

The claim recites "employing a processor executing computer-executable instructions stored on a

computer readable storage medium" which is unclear how processor is employed and tied to perform the invention. The rejection is maintained.

Previous Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   <u>Claims 1-14</u> are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, "computer implemented" (line 1) and "a processor" (line 3) are new matter. The rejection has been withdrawn because the Examiner has found support in the applicant's specification on pages 16-19.

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   <u>Claim 1-14, 27, 31 and 32</u> are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 3, 4, 13, 27, 31 and 32 each contain an improper Markush group (MPEP § 2173.05(h)). The applicant has amended the claim to overcome the rejection. The rejection has been withdrawn.

Non-Functional Descriptive Material

9.   The following claim language is non-functional descriptive material (printed matter) and was not given patentable weight (MPEP § 2106.01 and 706.03(a)A) as shown underlined below. Printed matter is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

Claim 4:

The system of claim 1 further teaches *the one or more enhancements comprising at least one of the following:*

bolded listing; addition of a background to listing; alternative color of listing; addition of icon to listing; addition of "preferred listing" text to listing; addition of thumbnail to listing; at least partial animation of listing; alternative font type of listing; alternative font size of listing; stylized font of listing; play of sound when hovering over listing; or preferred location on display of listing.

Claim 5:

The system of claim 4 *the one or more enhancements are visible* teach *when hovering over the respective listing.*

Claim 6:

The system of claim 4 *at least a portion of the listing is bolded.*

Claim 7:

The system of claim 4 *the alternative color of the listing is different from a standard color of the listings.*

Claim 8:

The system of claim 4 *the alternative color is based at least in part upon user preferences.*

Claim 9:

The system of claim 1 *the one or more enhancements do not influence determining whether enhanced listings are relevant to search query, thereby retaining ordering rights to keep listings relevant and meaningful to users.*

Claim 10:

The system of claim 1 *the one or more enhancements facilitate differentiating enhanced listings from other listings on a search results display.*

Claim 27:

The method of claim 21 *the one or more selected enhancement options comprising at least one of: bolding at least a portion of listing; adding a background to at least a portion of listing; changing text color of listing to an alternative color different from a standard listing color; altering text font of listing to be different from a standard listing font; increasing font size of listing greater than standard listing font size; animating at least a portion of listing; dynamically replacing at least a portion of listing with at least one search term; adding a thumbnail to the listing corresponding to some content of the listing; replacing listing text with a thumbnail that is representative of the content in the listing; adding an icon to the listing that indicates a preferred status of the listing; or positioning the listing apart from other listings while retaining ordering rights based on relevance of listing with respect to search query.*

Claim 28:

The method of claim 21 *globally applying the one or more enhancements to at least a subset of the plurality of listings.*

Claim 29:

The method of claim 21 as described above *the one or more enhancements are sensitive to at least one of cultural, time zone, and regional differences to mitigate offensive listings.*

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

11.   <u>Claims 1-2, 4, 11-15, 19-21 and 23-25</u> are rejected under 35 U.S.C. 103(a) as being unpatentable

over Rodriguez US Publication 2004/0059720 A1 in view of Wen US Publication 2001/0047297 A1.

Claim 1:

As per claim 1, **Rodriguez** teaches a computer implemented system comprising:

a processor communicatively coupled to a memory having stored thereon computer executable

instructions configured to implement the paid inclusion listing system including:

an enhancement controller component that controls a plurality of enhancements related to a paid

inclusion listing, the enhancement controller component interfacing with the paid inclusion customer to

facilitate optimizing enhancement selection based in part upon at least one of the following: listing

performance, historical data, customer preference, or user feedback (paragraphs 0007, 0023, 0042 and

0049).

Rodriguez teaches *related to a paid inclusion listing* (paragraphs 0007) does not teach *a selection*

component that allows a paid inclusion customer to select one or more enhancements. However, **Wen**

teaches an advertisement brokering with remote ad generation system and method in a distributed

computer network in paragraph 0002 and further teaches, *"As described herein, an advertisement*

generation characteristic is data representing a portion (whether visual, audio, or other) of the

advertisement which is influenced by the characteristic. Such characteristics include the size, shape,

color graphic, etc. available to the advertiser for selection" and *"The advertiser selects certain "ad*

generation characteristics" to change the appearance or the presentation of the advertisement. As

described herein, "ad generation characteristics" refer to varying ways an internet ad may be modified, as known in the art, such as adding color, text, etc" (paragraphs 0073 and 0074). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a component that allows an advertiser to select one or more enhancements. One would have been motivated to add a component that allows an advertiser to select one or more enhancements to allow the advertisers to highlight and distinguish listings from one another. Under KSR v. Teleflex (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art (Rationale F).

Claim 2:

As per claim 2, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above and **Rodriguez** further teaches *further comprising a display component operatively connected to the enhancement controller component for rendering one or more search results, the search results comprising at least one enhanced listing* (paragraphs 0023 and 0024).

Claim 11:

As per claim 11, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above and **Wen** further teaches *further comprising one or more enhancement components which are controlled by the enhancement controller component and which correspond to a plurality of enhancements available to the paid inclusion customer* (paragraphs 0073 and 0074). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add one or more enhancements controlled by enhancement controller component corresponding to enhancements available to advertisers. One would have been motivated to add one or more enhancements available to advertisers in order to provide the advertisers the ability to decide how the listing should be displayed or designed.

Claim 12:

As per claim 12, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above and **Rodriguez** further teaches *the user feedback comprising at least one of user hard-coded preferences and user behavior that facilitates customizing a manner in which the user views the listings* (paragraphs 0023 and 0024).

Claim 14:

As per claim 14, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above and **Rodriguez** further teaches *the enhancement controller component temporarily hides or suppresses one or more enhancements based at least in part upon user preferences* (paragraph 0023).

Claim 15:

As per claim 15, **Rodriguez** teaches a system comprising:

a processor communicatively coupled to a memory having stored thereon computer executable instructions configured to implement the paid inclusion listing system including:

one or more enhancement components that correspond to one or more enhancement options related to a paid inclusion listing (paragraphs 0007, 0023 and 0024);

a listing control component that controls the one or more enhancement components (paragraphs 0023 and 0024); and

a second input component that provides the listing control component with user preferences (paragraphs 0023 and 0024),*whereby the listing control component balances the customer's enhancement selections with user preferences to optimize listing performance with regard to enhancing the paid inclusion listing as presented to the user* (paragraph 0049).

Rodriguez does not teach *a first input component that provides the listing control component with a paid inclusion customer's enhancement selections.* However, **Wen** teaches an advertisement brokering with remote ad generation system and method in a distributed computer network in paragraph 0002 and further teaches, *"As described herein, an advertisement generation characteristic is data representing a portion (whether visual, audio, or other) of the advertisement which is influenced by the characteristic. Such characteristics include the size, shape, color graphic, etc. available to the advertiser for selection"* and *"The advertiser selects certain "ad generation characteristics" to change the appearance or the presentation of the advertisement. As described herein, "ad generation characteristics" refer to varying ways an internet ad may be modified, as known in the art, such as adding color, text, etc."* (paragraphs 0073 and 0074). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add an input component that provides an advertiser with enhancement selections. One would have been motivated to add an input component that provides an advertiser with enhancement selections in order for the advertiser to customize the display of the listing. Under KSR v. Teleflex (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art (Rationale F).

Claim 19:

As per claim 19, **Rodriguez** and **Wen** teach the system of claim 15 as described above and **Rodriguez** further teaches *the listing control component modifies one or more enhanced listings based at least in part upon a user's respective preferences on a per user basis* (paragraphs 0048 and 0049).

Claim 20:

As per claim 20, **Rodriguez** and **Wen** teach the system of claim 15 as described above but do not teach *the listing control component generates a plurality of parallel listings wherein at least a subset of the listings have respectively different enhancements to assist the paid inclusion customer in optimizing*

listing performance and revenues. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to generate a plurality of parallel listings with a subset of listings with different enhancements to help the advertiser select the listing leading to great performance and increased revenue. For example, consumer research marketing firms conduct research and surveys by asking questions to consumers regarding the appearance and effectiveness of similar but different advertisements. Once the feedback is generated, it helps advertisers determine advertisements that lead to expected increase in revenue, performance and success.

Claim 21:

As per claim 21, **Rodriguez** teaches a method comprising:

employing a processor executing computer-executable instructions stored on a computer readable medium to implement the following acts:

providing a plurality of listings to an end user (paragraph 0026) *including at least one paid inclusion listing* (paragraph 0007).

and rendering the plurality of listings based in part upon at least one of the one or more paid inclusion customers selected enhancement options and end user preferences (paragraph 0049).

Rodriguez does not teach *modifying at least a subset of the plurality of listings according to one or more paid inclusion customers selected enhancement options.* However, **Wen** teaches an advertisement brokering with remote ad generation system and method in a distributed computer network in paragraph 0002 and further teaches, *"As described herein, an advertisement generation characteristic is data representing a portion (whether visual, audio, or other) of the advertisement which is influenced by the characteristic. Such characteristics include the size, shape, color graphic, etc. available to the advertiser for selection"* and *"The advertiser selects certain "ad generation characteristics" to change the appearance or the presentation of the advertisement. As described herein, "ad generation characteristics" refer to varying ways an internet ad may be modified, as known in the art, such as adding color, text, etc."*

(paragraphs 0073 and 0074). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to modify a subset of the plurality of listings according to advertiser. One would have been motivated to modify a subset of the plurality of listings according to advertiser in order generate revenue and allow the advertiser to change the listings as needed. Under KSR v. Teleflex (82 USPQ 2nd 1385), the combination would be obvious because prior art elements are being combined according to known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art (Rationale F).

Claim 23:

As per claim 23, **Rodriguez** and **Wen** teach the method of claim 21 as described above but do not teach *further comprising modifying at least a subset of the plurality of listings according to user preferences*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to modify a subset of plurality of listings according to user preferences in order to present listings that comply with user's preferences.

Claim 24:

As per claim 24, **Rodriguez** and **Wen** teach the method of claim 23 as described above but do not teach *wherein modifying at least a subset of the plurality of listings according to user preferences overrides one or more selected enhancement options*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to modify at least a subset of the plurality of listing according to user preferences overrides one or more selected enhancement option in order to present a variety listings in a manner requested by user.

Claim 25:

As per claim 25, **Rodriguez** and **Wen** teach the method of claim 23 as described above but do not teach *wherein modifying at least a subset of the plurality of listings according to user preferences*

personalizes one or more selected enhancement options to respective users. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to modify a subset of the plurality of listings according to user preferences in order to provide the listing that is individualized and personalized to meet the users' expectations.

12.   Claims 3, 13, 16-18, 22 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 and Wen US Publication 2001/0047297 A1 as applied to claims 1 and 15 above, and further in view of Petropolous et al US Patent 7,042,502 B2.

Claim 3:

As per claim 3, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above but do not teach *the selection component is at least one of a pointing device, a stylus, a keyboard, a mouse, a joystick, and a touchpad.* However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, *"Mouse pointer 52 is common pointer, as may be controlled by a standard mouse, trackball, keyboard pointer, touch screen or any user manageable device hereinafter the term "mouse pointer" is used in the broadest sense the context permits to refer to any one or more of these navigation tools"* (column 3, lines 52-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a selection component is at least one of a pointing device, a stylus, a keyboard, a mouse, a joystick and a touchpad. One would have been motivated to add a selection component is at least one of a pointing device, a stylus, a keyboard, a mouse, a joystick and a touchpad in order to input information to a computing system.

Claim 13:

As per claim 13, **Rodriguez** and **Wen** teach the computer implemented system of claim 1 as described above but do not teach *further comprising a reporting component that provides reports comprising at least one of listing performance data, user feedback, historical data, or comparisons to historical data to the paid inclusion customer to facilitate optimizing revenues.* However, **Petropoulos**

teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, "*Preview information provides users with a tool to efficiently and thoroughly evaluate search prior to committing to a click through. There are aspects of the users evaluation processes that may be useful in factoring how well the search result matched the query for any particular user and query. Referring to FIG. 6, a client system 657 may be configured to monitor the keystrokes, mousing and related timing for a user reviewing a search results page that was generated elsewhere on the network and viewed on the client system 657. The results of the monitoring (or other attributes) may then be sent across the network to the either the search provider or the owner of the web page hosting the search*" (column 11, line 65 to column 12, line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a reporting component that provides reports comprising at least one of the following: listing performance data, user feedback, historical data, and comparisons to historical data to the paid inclusion customer to facilitate optimizing revenues. One would have been motivated to add a reporting component that provides reports comprising at least one of listing performance data, user feedback, historical data, and comparisons to historical data to the paid inclusion customer to facilitate optimizing revenues in order to improve the search results and provide the user an efficient method to search information.

Claim 16:

As per clam 16, **Rodriguez** and **Wen** teach the system of claim 15 as described above a monitoring component that monitors at least one of user behavior and user *responses to listings with or without enhancements to facilitate assessing implicit user preferences.* However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, *"The invention contemplates that there is monitoring while the user evaluates the results page. More particularly, the invention contemplates that there is monitoring of any or all of the following: (i) which result is being previewed by order or rank, (ii)the length of each preview, (iii) the order of previewing, (iv) the number of results previewed per page, and (v) whether there is a click-through. These attributes of the user behavior may be forwarded across the network to a program-designated*

place and later used in a consideration process, which will lead to conclusions about relevance of the results originally presented. These conclusions can be used to alter the algorithm and/or data so that the same or similar queries will yield more relevant results" (column 12, lines 22-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a monitoring component that monitors user behavior and user responses to listings with or without enhancements. One would have been motivated to add a monitoring component that monitors user behavior and user responses to listings with or without enhancements in order to study and gather information regarding user and search result.

Rodriguez and **Wen** do not teach *a reporting component that provides reports to respective paid inclusion customers regarding their respective listings and performance thereof.* However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, *"Preview information provides users with a tool to efficiently and thoroughly evaluate search prior to committing to a click through. There are aspects of the users evaluation processes that may be useful in factoring how well the search result matched the query for any particular user and query. Referring to FIG. 6, a client system 657 may be configured to monitor the keystrokes, mousing and related timing for a user reviewing a search results page that was generated elsewhere on the network and viewed on the client system 657. The results of the monitoring (or other attributes) may then be sent across the network to the either the search provider or the owner of the web page hosting the search"* (column 11, line 65 to column 12, line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a reporting component that provides reports to advertisers. One would have been motivated to add a reporting component that provides reports to advertisers in order to gather data regarding search results.

Claim 17:

As per claim 17, **Rodriguez**, **Wen** and **Petropoulos** teach the system of claim 16 as described above but do not teach *the monitoring component operatively connected to the listing control component*

to facilitate balancing the customer's enhancement selections with implicit user preferences. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to balance the advertiser's enhancement selections with implicit user preferences in order to satisfy both advertisers and users requirements.

Claim 18:

As per claim 18, **Rodriguez**, **Wen** and **Petropoulos** teach the system of claim 17 as described above but do not teach *the listing control component stores user preferences including implicit user preferences and hard-coded preferences in one or more databases.* However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to store implicit user preferences and hard-coded preferences in one or more databases. For example, department and grocery stores have computers equipped with databases with stored information related to the customer (shopping information, surveys, demographics, etc.).

Claim 22:

As per claim 22, **Rodriguez** and **Wen** teach the method of claim 21 as described above but do not teach *further comprising reporting performance of at least a subset of the plurality of rendered listings to respective paid inclusion customers to facilitate optimizing listing performance and revenues.* However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, *"Preview information provides users with a tool to efficiently and thoroughly evaluate search prior to committing to a click through. There are aspects of the users evaluation processes that may be useful in factoring how well the search result matched the query for any particular user and query. Referring to FIG. 6, a client system 657 may be configured to monitor the keystrokes, mousing and related timing for a user reviewing a search results page that was generated elsewhere on the network and viewed on the client system 657. The results of the monitoring (or other attributes) may then be sent across the network to the either the search provider or the owner of the web page hosting the search"* (column 11, line 65 to column 12, line 10). Therefore, it would have

been obvious to one of ordinary skill in the art at the time of the invention for Rodriguez to report performance of at least a subset of rendered listings to respective paid inclusion customers. One would have been motivated to report performance of at least a subset of rendered listings to respective paid inclusion customers in order to gather data regarding search results.

Claim 30:

As per claim 30, **Rodriguez** and **Wen** teach the method of claim 21 as described above but do not teach *further comprising hovering a pointing device over rendered enhanced listing to visualize enhancement.* However, **Petropoulos** teaches methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-23, and further teaches, *"A feature of the current invention is that the user is shown preview information when the mouse pointer 52 navigates or passes over a defined area such as first defined area 60, second defined area 61, or other defined areas 62, 64, 66, 61, 68 (Hereinafter, the action of navigating or passing the mouse pointer over a region is referred to as a "mouse over")."* and *"In one embodiment, upon a pre-defined placement or action of the pointer (e.g. mouse-over), instructions are sent to the user's web browser to automatically open an embedded preview window and render the relevant contextual information inline with the user's result"* (column 4, lines 1-7 and lines 10-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Rodriguez to add a pointing device over rendered enhanced listing to visualize enhancement. One would have been motivated to add a pointing device over rendered enhanced listing to visualize enhancement in order to provide the user a graphical illustration of the listing.

13.   Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodriguez US Publication 2004/0059720 A1 in view of Petropolous et al. US Patent 7,042,502 B2.

Claim 31:

As per claim 31, **Rodriguez** teaches a method comprising:

employing a processor executing computer-executable instructions stored on a computer readable medium to implement the following acts:

enhancing at least a first subset of the plurality of listings, the first subset including the at least one paid

inclusion listing, with the at least a first paid inclusion customer selected enhancement (paragraphs 0007,

0023 and 0024).

enhancing at least a second subset of the plurality of listings, the second subset including the at least one

paid inclusion listing, with at least a second enhancement, the second enhancement paid inclusion

customer selected being different from the first paid inclusion customer selected enhancement such that

the modified paid inclusion listing as represented in the second subset (paragraphs 0023, 0024 and

0049).

Rodriguez does not teach *generating a plurality of parallel listings including at least one paid*

inclusion listing. However, it would have been obvious to one of ordinary skill in the art at the time of the

invention of Rodriguez to generate a plurality of parallel listings in order to provide the advertiser a listing

with different enhancements.

Rodriguez does not teach *and reporting at least one of performance, user historical data, or end-*

user behavior with respect to the first and second subsets of the plurality of listings to respective paid

inclusion customer to optimize listing performance and revenues. However, **Petropoulos** teaches

methods and apparatus for mouse-over preview of contextually relevant information in column 1, lines 16-

23, and further teaches, *"Preview information provides users with a tool to efficiently and thoroughly*

evaluate search prior to committing to a crick through. There are aspects of the users evaluation

processes that may be useful in factoring how well the search result matched the query for any particular

user and query. Referring to FIG. 6, a client system 657 may be configured to monitor the keystrokes,

mousing and related timing for a user reviewing a search results page that was generated elsewhere on

the network and viewed on the client system 657. The results .of the monitoring (or other attributes) may

then be sent across the network to the either the search provider or the owner of the web page hosting

the search" (column 11, line 65 to column 12, line 10). Therefore, it would have been obvious to one of

ordinary skill in the art at the time of the invention of Rodriguez report at least one of performance, user

historical data, and user behavior with respect to the first and second subsets of listings. One would have

been motivated to report at least one of performance, user historical data, and user behavior with respect

to the first and second subsets of listings in order to gather data regarding search results.

Claim 32:

As per claim 32, **Rodriguez** and **Petropoulos** teaches the method of claim 31 as described

above and **Rodriguez** further teaches *further comprising optimizing delivery of listings based at least in*

part upon at least one of the following: a user point of entry comprising a web-based entry and a user-

application entry, time of day, or display device (paragraphs 0023 and 0024).

Response to Arguments

14.   Applicant's arguments filed 06 May 2009 have been fully considered but they are not persuasive.

According to the applicant's arguments on page 10 of the remarks disclose the following:

"The Office asserts that substantial portions of the claimed subject matter are not afforded

patentable weight where the claim language is deemed non-functional descriptive material.

Applicants' representative respectfully disagrees with this position. These enumerated aspects of

the disclosed subject matter, for example, clearly alter how a paid inclusion listing is enhanced or

interacts. As such, each of the more narrowly drawn particular enumerated examples describe

that which the applicants believe is well within the scope of their disclosed subject matter. For

instance, these particular enumerated enhancements are not mere non-functional descriptive

language because they specifically disclose a particular enhancement that may not have the same

effect on a user as a different enumerated enhancement *(e.g.,* were the enumerated enhancements

merely non-functional, then the enhancements would be completely interchangeable without any

effect, which is certainly not the case) *(see* how different enhancements can have a substantial

effect on the consumption of listings as presented in the specification at pare 11, line 24 to pare

12, line 2; pare 15, lines 14-18; etc.)". The Examiner finds the applicant's arguments not persuasive

because the claimed subject matter (claims 4-10 and 27-29) is non-functional descriptive material. The

enhancement of listings is aesthetic in nature and does not substantially change or alter the performance of the "invention". No patentable weight is given to ideas that make the invention aesthetically pleasing to the intended user or customer.

15.   Applicant's arguments been fully considered but they are not persuasive. According to the Applicant's arguments on page 12 of the remarks disclose the following:

"The Examiner states that the applicant has "defined" a paid inclusion customer as an "advertiser", applicants' representative STRONGLY disagrees. The specification, as filed, at the portion cited by the Examiner, merely states: "[a provider] can offer...enhancements to paid inclusion customers (hereinafter, referred to as "advertisers") to affect the rendering of any paid inclusion listing...", illustrating that the term advertiser can be used as a shorthand notation for the longer term 'paid inclusion customer' as used in the present application, which is reasonably interpreted to mean that *not all advertisers are paid inclusion customers.*" The Examiner notes the specification has not provided an explicit definition for paid inclusion customer. According, to the specification a paid inclusion customer is described as "As shown in Fig. 1. a paid inclusion customer such as an advertiser can employ a paid inclusion..." on page 8.

Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example. The Examiner has interpreted paid inclusion customer as an advertiser.

16.   Applicant's arguments been fully considered but they are not persuasive.   According to the Applicant's arguments on page 12 of the remarks disclose the following: "More specifically, claim 1 recites, "a selection component that allows *a paid inclusion customer to select one or more enhancements' related to a paid inclusion listing",* emphasis added. Rodriguez is silent with regard to this aspect, merely disclosing end user enhancements to text that cannot be considered a paid inclusion listing." However, the Examiner points out to Rodriguez teaching and suggesting paid inclusion listings in paragraph 0007 disclosing *"Because of its effectiveness, the practice of paying for enhanced ranking position rapidly became widespread. Unfortunately, this practice introduces a substantial imperfection into the frictionless marketplace that the Web can become, because millions of naive users are being frequently directed to sites which have paid a premium for preferred placement, rather than to sites which may have more pertinent information. In theory, the Web makes it possible for customers to locate the best supplier, but it can deliver on that promise if the process is objective." [paid inclusion listings].*

17.   Applicant's arguments on pages 12 and 14 of the remarks disclose the following: "The Office then turns to Wen to cure the defects of Rodriguez, namely that paid inclusion listings can be enhanced by the paid inclusion listing customer. Wen, in fact, does not disclose this aspect" for claim 1 and "modifying at least a subset of the plurality of listings according to one or more paid inclusion customer selected enhancements" for claim 21. The Wen reference does teach a selection component that allows a paid inclusion customer to select one or more enhancements by disclosing the following: *"As described herein, an advertisement generation characteristic is data representing a portion (whether visual, audio, or other) of the advertisement which is influenced by the characteristic. Such characteristics include the size, shape, color graphic, etc. available to the advertiser for selection"* and *"The advertiser selects certain "ad generation characteristics" to change the appearance or the presentation of the advertisement. As described herein, "ad generation characteristics" refer to varying ways an internet ad may be modified, as known in the art, such as adding color, text, etc"* (paragraphs 0073 and 0074).

18.   Applicant's arguments on page 14 of the remarks disclose the following: "Moreover, neither Rodriguez nor Wen disclose or suggest, "the listing control component *balances the customer's enhancement selections with user preferences* to optimize listing performance" in regards to claim 15. However, Rodriguez teaches, "The clients can control how their Web sites are classified for the purposes of a search.   In addition, they can now use new meta tags to allow multimedia files to be searched in the same manner as text files, and to present multimedia advertisements or samples on the search results page to entice a user to visit their Web site. Likewise, users can control what categories they wish to see and how they want the search results to be presented. As a result, both the client and the user have greater control of how search results are presented.   In addition, multimedia data can be streamed directly to the search page without requiring the user to link to the Web site represented by an icon in the search results." (paragraph 0049).

19.   Applicant's arguments on page 16 of the remarks disclose the following: "As such, Petropoulos does not disclose of suggest the recited claim language, "a reporting component that provides reports comprising at least one of [paid inclusion] listing performance data, user feedback, historical data, or comparisons to historical data *to the paid inclusion customer to facilitate optimizing revenues"*, emphasis added." However, Petropoulos does teach the recited claim language by disclosing, *"Preview information provides users with a tool to efficiently and thoroughly evaluate search prior to committing to a click through. There are aspects of the users evaluation processes that may be useful in factoring how well the search result matched the query for any particular user and query. Referring to FIG. 6, a client system 657 may be configured to monitor the keystrokes, mousing and related timing for a user reviewing a search results page that was generated elsewhere on the network and viewed on the client system 657. The results of the monitoring (or other attributes) may then be sent across the network to the either the search provider or the owner of the web page hosting the search"* (column 11, line 65 to column 12, line 10).

20.   Applicant denies the rejection without distinctly and specifically pointing out the supposed errors in the examiner's action. It is not sufficient to point out the supposed errors in the examiner's action. This fails to comply with 37 CFR 1.111(b). For example, on pages 14 and 17 of the remarks, applicant attempts to traverse the rejection of claims 31-32 but does not distinctly and specifically point out the supposed errors in the examiner's action regarding obviousness.

Conclusion

        THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

        Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW L. HAMILTON whose telephone number is (571)270-1837. The examiner can normally be reached on Monday-Friday 7:30a.m-5p.m EST alt Fridays off.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Weinhardt can be reached on (571) 272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application
Information Retrieval (PAIR) system. Status information for published applications may be obtained from
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or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-
1000.

MLH   /Donald L. Champagne/
Examiner, Art Unit 3688   Primary Examiner, Art Unit 3688
August 3, 2009   571-272-6717